

REMARKS

Claims 1-19 are pending in this application. By this Amendment, Applicants amend claims 1, 9, and 19. Support for the amendments to claims 1 and 9 may be found at least on page 4, lines 1-6 and Fig. 2, element 38. Applicants respectfully request reconsideration of the pending claims at least in light of the following remarks.

The Office Action Rejects claims 1-7 and 9-16 under 35 U.S.C. §103(a) over Price, et al., "Linking by Inking: Trailblazing in a Paper-Like Hypertext" (hereinafter "Price") in view of Golovchinsky, et al., "From Reading to Retrieval: Freeform Ink Annotations as Queries" (hereinafter "Golovchinsky"). Applicants respectfully traverse the rejection.

Neither Price nor Golovchinsky disclose, teach, or suggest that "each of the at least two documents are pre-selected as the source document and the at least one target document from the at least one database by a user of the system," as recited in claims 1 and 9.

Both Price and Golovchinsky disclose systems and methods wherein a source document is annotated (Price pp. 33 and 34; Golovchinsky pp.19-22). Each annotation is converted into a query and a database is searched for other documents related to the query (Id). Importantly, according to both Price and Golovchinsky each document that is returned by the search is unknown to the user prior to the search and thus cannot be "pre-selected."

Relying on the dictionary definition of pre-select, the Office Action alleges that because the documents in Price come from the XLibris database, the documents within the XLIBS database have been pre-selected by a user of the system, presumably compared to documents not contained in the XLibris database (pages 3 and 7 of the Office Action).

However, because, as discussed above, the specific documents that are returned by the search are unknown to the user prior to the search and thus cannot be "pre-selected." Thus, according to Price, even if the documents of the XLIBS database are pre-selected by a user as

alleged by the Office Action¹, the at least one target document is not pre-selected from the database as the target document, as recited in claims 1 and 9.

Applicants respectfully reiterate that the above described deficiency of Price and Golovchinsky results from a fundamental difference between the objects of Price and Golovchinsky and the inventions recited in claims 1 and 9. The systems and methods of Price and Golovchinsky search for new information (see e.g., Price, "Introduction," and Golovchinsky, "The Problem"). The system of claim 1 and the method of claim 9 apply similar annotations to other known documents to aid in review and revision of those other known documents (see e.g., page 1, lines 14-21; page 3, lines 17-32). Because the systems and methods of Price and Golovchinsky help a user search for documents within a database, those documents cannot be known to a user before the search and thus cannot be "pre-selected."

Because neither Price nor Golovchinsky disclose, teach, or suggest that "each of the at least two documents are pre-selected as the source document and the at least one target document from the at least one database by a user of the system," claims 1 and 9 are patentable over the asserted combination of Price and Golovchinsky. Further, Applicants respectfully submit that claims 2-7 and 10-16 are patentable for at least the reasons that claims 1 and 9 are patentable, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection.

The Office Action Rejects claims 8 and 17 under 35 U.S.C. §103(a) over Price and Golovchinsky in view of U.S. Patent Application 6,363,179 to Evans et al. (hereinafter "Evans"). Applicants respectfully traverse the rejection.

¹ Applicants do not acquiesce in the Office Actions reasoning with respect to its interpretation of Price disclosing pre-selection, but simply propose a hypothetical noting that even if the Office Action's reasoning were sound, claims 1 and 9 are still patentable of Price and Golovchinsky.

This rejection is premised upon the presumption that Price and Golovchinsky disclose, teach, or suggest all of the features of claims 1 and 9. Because, as discussed above, neither Price nor Golovchinsky disclose all of the features of claims 1 and 9, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

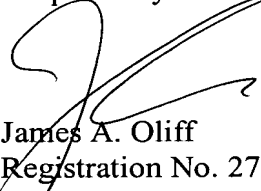
On page 6, the Office Action appears to reject claim 19 under 35 U.S.C. §103(a) over Price in view of Golovchinsky. Applicants respectfully traverse the rejection.

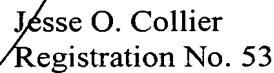
As discussed above, even if Price may be considered to disclose pre-selecting the contents of a database, neither of Price nor Golovchinsky disclose, teach, or suggest that the target document is pre-selected as the target document as recited in claim 19. Accordingly, claim 19 is patentable over the combination of Price and Golovchinsky. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-19.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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Attachment:
Request for Continued Examination

Date: August 4, 2005

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